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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,112	09/27/2004	Wassilios Grammenos	53376	1295
26474 7590 07/03/2007 NOVAK DRUCE DELUCA & QUIGG, LLP 1300 EYE STREET NW SUITE 1000 WEST TOWER WASHINGTON, DC 20005				
			EXAMINER PRYOR, ALTON NATHANIEL	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 07/03/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/509,112

Applicant(s)

GRAMMENOS ET AL.

Examiner

Alton N. Pryor

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 and 17 is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-14 and 18-21 is/are rejected.
- 7) ☒ Claim(s) 6-8, 15 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-5, 10-14, 18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Seitz et al (WO 96/17825; 6/13/96). Claims 19-21 are added to this rejection. Seitz suggests a compound of formula I where Ar₂ is a phenyl that is substituted with 2 alkoxy groups, A₁, A₂ and A₃ = H, m = 2, E is =CHR₁ where position 1 on the moiety bears an optionally substituted heteroaryl (Ar₁)-G-Z and the R₁ on position 2 of the moiety bears alkyl (Me, Et, Pr), G = bond, and Z = halogen, alkyl (Me, Et, Pr) or alkoxy (O-Me, O-Et, O-Pr). The substitution on the heteroaryl can be halogen, alkyl, etc. This compound taught by Seitz is equivalent to compound of instant formula I in the instant claims. Seitz teaches that his compounds can be combined with carriers to produce a composition. Seitz also teaches a method of applying the composition to materials to control fungi growth. See abstract, page 5 line 31 – page 7 line 10, pages 40-44. Seitz does not exemplify a specific compound of instant formula I and does not exemplify a method of applying the compound to material to control fungal growth. However, at the time of Seitz's invention one having ordinary skill in the art would have been expected to make the instant compound of formula I and apply it to materials to

control fungal growth. One would have been motivated to do this since Seitz suggests the instant compounds and their application to materials to control fungal growth.

Response to Applicants' Argument

I. Applicants Argue:

- A. It is urged that the generic disclosure which is provided by the teaching of Seitz and from which the Examiner selected denotations in order to construe the applicants compounds (I) cannot be deemed to provide any information which would have led a person having ordinary skill the art at the time the invention was made who was unaware of applicants' invention to make the specific selection which was made by the Examiner.
- B. It is necessary that the references suggest the desirability and obviousness of making the combination, i.e. the prior art must motivate an artisan to select the claimed species or subgenus.
- C. The generic formula, which is disclosed by Seitz, embraces a broad range of compounds but also allows for considerable structural diversity of the compounds.

II. Examiner argue:

The fact that Seitz teaches a number of substituents, including the substituents which would lead to the instant group of compounds, makes the instant group of compounds obvious. Applicant has provided no data, which would suggest that the instant compounds would yield different data from the other compounds taught by Seitz. For example Seitz teaches numerous groups for E including the

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CH=NR4 group instantly claimed. However, Applicants' do not show that CH=NR4 provides unexpected results when compared to the other possible E groups taught by Seitz. Note this is only an Example of what the Examiner is looking for to overcome Seitz. It is very possible that the unexpected activity may reside in a different group besides E. Note that a reference does not have to exemplify all possible arrangements of a compound in order to make a claimed compound obvious. However, when a reference embraces a compound claimed but does not specifically teach or exemplify the compound claimed, it is critical of the Applicant to show some unexpectancy of the compound being claimed.

Claim Objection / Allowable Subject Matter

Claims 6-8,15,16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 9 and 17 are allowable. The prior art does not teach or suggest the instant method of making compound of instant formula I using compound of formula III or IV or compound in claim 8. The prior art does not teach or suggest the compound of formula II'.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Alton Pryor
Primary Examiner

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